

### REMARKS

1. The application was filed with Claims 1-37 and all claims remain pending. The claims are rejected under section 102(b), 103(a) and 112, second paragraph, of the Patent Act. The Examiner is thanked for pointing out the typographical error in Claim 30 of the present application. Claim 30 has been amended to correct the error. Correcting the typographical error also corrects the error for which Claim 30 was rejected under section 112, second paragraph. Reconsideration and reexamination is respectfully requested.

2. Claims 32, 34, and 36 are rejected under 35 U.S.C. § 102(b) as being anticipated by each of U.S. Pats. No. 2,102,052 (Yearly), 4,463,018 (Carr), and 5,007,194 (Coody). Each of the references teaches fish bait. These claims recite a crustacean bait, crustacean defined in the application as the biological class that includes lobster and crabs. See application, paragraph [0002]. In order to make out a prima facie rejection for anticipation, the prior art must teach all the limitations of the claims. Since the references cited do not teach crustacean bait, the Office Action fails to make a prima facie rejection.

i. The prior art does not teach or suggest crustacean bait, only fish bait, and thus does not anticipate Claims 32, 34 and 36.

Crustaceans are generally defined as a large class of mostly aquatic mandibulate arthropods that have a chitinous or calcareous and chitinous exoskeleton, a pair of often much-modified appendages on each segment, and two pairs of antennae; the class generally includes lobsters, shrimps, crabs, wood lice, water fleas, and barnacles. Merriam-Webster's Collegiate Dictionary, 10th ed. at 280. The prior art cited, however, teaches fish bait, and does not teach or suggest bait for crustaceans as claimed. Bait for crustacean traps differs from fish bait in that crustacean bait is placed in submersed traps or pots, and the bait should last, or be effective, for at least ten to fourteen days in warmer water or three to four weeks in cold water. Application, paragraph [0051]. In contrast, fish bait is suitable for use over a period of hours, not days or weeks. See U.S. Pat. No. 3,964,203 to William Williams, col. 3, lines 35-37. The references teach fish bait, not bait for crustaceans. Claims 32, 34 and 36 are not anticipated and are therefore allowable.

ii. These claims are written as product by process claims and the claims do include the steps of the process

The rejections state that these claims, product by process claims, may not consider the steps of the process used to make them, citing old case law: In re Brown, 173 U.S.P.Q. 685 (C.C.P.A. 1972) and In re Wertheim, 191 U.S.P.Q. 134 (C.C.P.A. 1976).

More recent case law is more in accord with M.P.E.P. 2173.05(p), which states that product by process claims are proper. In addition, careful analysis of more recent case law shows that the steps of the process are to be considered if the product is novel and is distinguishable from similar prior art products. See *Atlantic Thermoplastics Co., Inc., v. Faytex Corp.*, 970 F.2d 834 (Fed. Cir. 1992) (holding that process steps were claim limitations). The issue in these cases is typically whether the product is novel, that is, is not in the prior art and is best described by the process by which it is made, or whether the process limitations merely narrow the scope of the previously-known product. See *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1317 (Fed. Cir. 2006).

In the present application, crustacean bait and the steps used to prepare crustacean bait constitute limitations of the claim. Accordingly, Claims 32, 34 and 36 include all the limitations of the claims from which they depend, Claims 1, 33 and 35, respectively. The prior art does not teach or suggest crustacean bait nor does it teach the limitations of the method claims as applied to crustacean bait. Accordingly, Claims 32, 34, and 36 are not anticipated by the prior art and are allowable.

3. Claims 1, 35, and 37 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 4,484,924 to Ernst Pfleiderer et al. ("Pfleiderer"). The rejection asserts that each step of these claims are shown by Pfleiderer. Applicants believe that the rejection is intended for Claims 1, 33, 35 and 37, since these claims involve steps, and this response is prepared in that belief. If this is incorrect, please apply these arguments to Claims 1, 35, and 37 only.

Pfleiderer teaches a process for producing unhaired, storable hides and skins. Pfleiderer does not teach, suggest or even mention bait for fish or for crustaceans. Each of Claims 1, 33, 35 and 37, however, concern a process for making crustacean bait, in which the preamble breathes life and meaning into the claim, and is thus a limitation of the claim. M.P.E.P. 2111.02. Thus, the claims distinguish over the prior art. Nevertheless, to make it absolutely clear that the processes as claimed refer to crustacean bait, and a process for making crustacean bait, the claims have been amended to recite this limitation in the body of the claim as well as in the preamble. In addition, a limitation from Claim 24 has been added to further differentiate these claims from the prior art. Support for the amendment is found at least in the specification at paragraph [0018] and at Claim 23 as filed. Claims 23 and 24 have also been amended in accordance with the amendments to Claim 1. The Examiner is respectfully requested to pass these claims to allowance.

4. Claims 1-29 and 31-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable in view of U.S. Pat. No. 3,964,203 to William Williams ("Williams") and U.S. Pat. No. 4,463,018 to William Carr ("Carr"), in view of U.S. Pat. No. 4,484,924 to Ernst Pfeleiderer ("Pfeleiderer"), U.S. Pat. No. 6,827,041 to Frank Hague et al. ("Hague"), U.S. Pat. No. 3,408,918 to Robert Talty et al. ("Talty"), and U.S. Pat. No. 4,224,028 to Geraldine Thiele ("Thiele"). The Office Action states that using rinds and skin was well known in the prior art, and admits that Williams and Carr do not teach the steps of preparing fishing lures using the steps recited in the present claims. The rationale cited for combining the references is that one would be motivated to combine the Pfeleiderer, Talty, Thiele, and Hague references with Carr and Williams in order to convert hides or skins into stable substances that will not putrefy.

The references do not teach all the limitations of independent Claims 1, 33, 35, and 37

Williams however, teaches the use of chamois (soft leather) to which is added animal blood as a fish attractant. See col. 2, lines 55-60. See also claims 1 and 3, requiring animal blood as part of Williams' fish bait. As noted in the present application, crustacean bait must last for many days or weeks when in use—this is one way in which crustacean bait, such as that used in lobster traps, differs from fish bait. See Application paragraph [0051]. Fish bait with animal blood as an attractant will clearly not last very long – the blood will quickly seep out after only a few hours and there will be no more fish attractant, as admitted by Williams himself. See Williams, col. 3, lines 35-37. Carr, directed to aquatic bait, does no better, since Carr does not even teach the use of hides, but rather cheesecloth, thus teaching away from the use of natural hides or skin. See col. 5, lines 30-42. As admitted in the Office Action, Williams and Carr do not teach the steps of the methods recited in Claims 1-29 and 31-37. See Office Action, p. 3, last two lines. Accordingly, the combination of Williams and Carr does not teach or suggest crustacean bait or, as admitted in the Office Action itself, the claimed methods for making crustacean bait. Thus, the Office Action fails to make out a prima facie rejection for obviousness of Claims 1-29 and 31-37.

There is insufficient motivation to combine the references

The Office Action cites no motivation for combining Williams and Carr, the Office Action simply stating that Williams is directed to using rinds and skins as a fishing lure, and that Carr is directed to using hide as artificial bait. This is incorrect, since Carr teaches the use of cheesecloth, not skins, as the basis for bait. See Carr, col. 5, lines 30-

42. As admitted in the Office Action, Williams and Carr do not teach crustacean bait or the steps of the methods of the rejected claims. Office Action, p. 3, last two lines. The rejection is thus improper, since there is no stated motivation to combine at least Williams and Carr, and these references admittedly do not teach the steps of the claimed methods.

The rationale cited for combining the additional references is that one would be motivated to combine the Pfleiderer, Talty, Thiele, and Hague references with Carr and Williams in order to convert hides or skins into stable substances that will not putrefy. Since Carr teaches cheesecloth, which does not putrefy, and Williams teaches chamois, which is already treated, there would be no motivation to combine Williams and Carr with the other references. In order to make out a prima facie reference, there must be a motivation to combine the references. M.P.E.P. 2143. Accordingly, the Office Action fails to make out a prima facie rejection of Claims 1-29 and 31-37.

The references also do not teach many of the additional process limitations of the dependent claims

All temperatures in the present application are in degrees Fahrenheit. See Application, paragraph [0030]. The rejection, however, states that it would have been obvious to use temperatures of rinse liquids above 100°C "for the logical scientific fact of removing fat and grease." Office Action, p. 5, lines 6-10. As should be obvious, water temperatures above 100°C cannot be used without pressure vessels or other special equipment, which is not contemplated by the present application. However, since it would be obvious to use temperatures above 100°C, Claims 3, 6, 9, and 21, reciting several specific temperatures well below 100°C, should be patentable in view of the prior art. Accordingly, at least Claims 3, 6, 9, and 21 are allowable.

There is also no prior art cited for the rejection of several claims, e.g., Claim 4, which recites that the alkali material is about fourteen percent of the weight of the hides or skins, or Claim 10, which recites that about one pound of acidic material is used for fifty pounds of hides or skins. In a similar manner, no prior art is cited for the limitations of Claim 15, which recites using an amount of salt that is about twenty percent by weight of the hides. There is also no art cited for the use of a brightening agent such as hydrogen peroxide, as recited in Claims 17 and 18.

In order to make out a prima facie case of obviousness, there must be some motivation to combine the references, and the references must teach or suggest all the limitations of the claims. In the present rejection, there is scarcely any motivation to

combine the references. Indeed, one of the principal references, Carr, teaches the use of cheesecloth rather than hides in preparing fish bait (not crustacean bait), which avoids the problems of putrefaction which the other references seek to solve.

In addition, the references must teach or suggest all the limitations of the claims, including crustacean bait, which the cited references, teaching fish bait, clearly do not. Therefore, the Office Action fails to make out a prima facie rejection of Claims 1-29 and 31-37. The Examiner is respectfully requested to allow these claims of the present application.

5. Claim 30 is rejected under 35 U.S.C. § 103(a) as being unpatentable in view of U.S. Pat. No. 4,484,924 to Ernst Pfeleiderer ("Pfeleiderer") in view of U.S. Pat. No. 3,670,534 to Bruce Gould ("Gould") and U.S. Pat. No. 3,913,360 to Eric Holdsworth ("Holdsworth"). The rejection provides no motivation for combining Gould and Holdsworth with Pfeleiderer, simply stating that the prior art devices taught by Holdsworth and Gould "would have been within the ambit of ordinary skill." Office Action, p. 6, lines 8-10.

As noted above, the independent claims of this application, including Claim 1 from which Claim 30 depends, are allowable because the references do not teach crustacean bait or methods for producing crustacean bait. Claim 30 is allowable at least because Claim 1 is allowable.

6. The application is considered in form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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